

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JEFFREY J. ZETTLE et al.

Appeal No. 2004-1271
Application No. 09/370,913

HEARD: August 18, 2004

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 25, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention generally relates to a lid for a container that is useful in storing or transporting items such as food, and more particularly, to a selectively detachable container lid having unique venting and denesting features, and a container employing the same (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Dokoupil et al. (Dokoupil)	3,773,207	Nov. 20, 1973
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Claims 1, 3 to 5, 8 to 12, 15 to 22 and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Dokoupil.

Claims 6, 7, 13, 14, 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dokoupil.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 30, mailed August 29, 2002) and the answer (Paper No. 36, mailed

October 7, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 35, filed July 18, 2003) and reply brief (Paper No. 38, filed December 3, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In the brief (p. 5), the appellants state that claims 1, 3 to 7, 9 to 17 and 19 to 24 rise or fall together and that claims 8, 18 and 25 rise or fall together. In accordance with the appellants grouping of claims and arguments provided, we need to review only the rejection of claims 1 and 8 to decide this appeal.

Claims 1 and 8 read as follows:

1. A lid for use with a bowl having a sidewall terminating in a rim, said lid comprising:
 - a center panel;
 - a peripheral sealing lip surrounding said panel, said peripheral sealing lip having a generally inverted U-shaped cross section so as to define a channel into which the rim fits; and
 - at least one ridge formed between said panel and said peripheral sealing lip, said ridge being interrupted by at least one gap, wherein said ridge and said

peripheral sealing lip at least partially overlap when viewed in a direction substantially normal to said panel, and said ridge abuts the rim of the bowl when said lid is placed loosely on the bowl, and said at least one gap defines an air passageway between the rim of the bowl and said lid when said lid rests loosely on the bowl such that the channel is substantially aligned with the rim of the bowl.

8. A lid according to claim 1, wherein the generally inverted U-shaped cross section of said peripheral sealing lip includes an outer wall from which a rigid tab member extends.

Dokoupil discloses a thermoplastic container package 10 comprised of an open-ended container 12 and a lid 24. The container 12 has a closed base 14, sides 16 and a continuous circumferential groove 18. Sides 16 terminate in an integral substantially horizontal rim 20 and an integral descending flange 22. Lid 24 has a central panel 26, a generally vertical wall W and a substantially horizontal rim 30 which terminates in a descending flange 32 having an integral tab 34. Wall W of lid 24 has a substantially vertical wall portion 28 and a substantially horizontal step 36 extending inward from generally vertical wall portion 28 and toward the center of central panel 26. The lower wall portion 38 of wall W below the substantially horizontal plane of step 36 extending downwardly from the direction of central panel 26, has a plurality of stacking lugs 38' which protrude slightly further inwardly from the edge of step 36 and from the downwardly and outwardly extending lower portions 38 of wall W.

Dokoupil's lid 24 has a substantially continuous score line 46 in the undersurface of lid rim 30 and substantially diagonally to where it adjoins the edges of tab 34 where the tab adjoins lid flange 32. Tab 34 is not sealed to underlying container flange 22, but lid flange 32 to either side of tab 34 is sealed to flange 22. Lid 24 also includes an outwardly protruding lid closure bead 40 peripheral to central panel 26 and adjoining panel 26 and the aforementioned lower portion of wall W. The bead can be continuous around panel 26 but preferably it tapers off to non-existence adjacent and below the tab. This tapering facilitates removal and closure of lid 26 on container 10. The continuity of bead 40 is broken by a plurality of vents or channels 42 carved therein, which run substantially vertically from the bottom surface of central panel 26 to the top of bead 40 and which can be aligned with and feed into the stacking lugs 38' of wall W. Dokoupil teaches (column 4, lines 5-8) that "[v]ents 42 allow air to escape from the interior of container 12 and exit into, i.e., behind stacking lugs 38' when lid 24 is securely placed on container 12." Dokoupil further teaches (column 4, lines 46-50) that "[v]ent 42 runs from the bottom surface of central panel 26 to the top of lid closure bead 40 and, as previously stated, allows air to escape from the container when lid 24 is closed on the container 12."

A tight and secure reclosure of lid 24 on container 12 can be effected by setting the lid on the container and pushing downward until a tight-fit-implying "popping" sound

is heard as lid closure bead 40 coacts with and seats itself within groove 18 of container 12. Reclosure and initial closure or capping is facilitated by vents 42 carved vertically in lid closure bead 40 which allow otherwise trapped and resisting air pressure to escape through the vents from the container. Stacking lugs 38' in lid 24 allow many such lids to be nested on one another because they prevent the central panels of overlying lids from becoming blocked or lodged within the substantially vertical wall W or underlying lids. Lugs 38' can be of any practical number or size. Preferably, six to eight lugs are employed and preferably they are equidistant from each other. The lugs can protrude inward to any extent sufficient to prevent the aforementioned lodging.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

The appellants argue that claim 1 is not anticipated by Dokoupil since there is no disclosure that Dokoupil *necessarily* vents if the lid rests loosely on the bowl as claimed. It is the appellants position that what happens in Dokoupil during the process of securing the lid 24 to the container 12 is that the lid is initially placed on the container, and the bottom of the beads 40 and the vents 42 rest on the first horizontal part of the container below the flange 20. The appellants assert that no air can escape through the vents 42 in this position. Next, the lid is pressed downward, flexing the vertical sidewall of the container outward. While this is occurring, air can escape through the vents 42 to the area behind the lugs 38', until the lid is secure on the container, at which time the container flexes back to its original position where, according to the appellants, no air can escape. Thus, the appellants allege that Dokoupil vents during the process of securing the lid but does not vent with the lid either securely or loosely positioned. The appellants submit that it by no means necessarily follows that venting occurs when the lid is securely positioned, merely because venting occurs as the lid is being securely positioned.

The appellants believe that the foregoing indicates that the examiner's logic (i.e., if Dokoupil vents the container when the lid is secure, it must vent when the lid is loose), is based on a false premise. Viewing the disclosure as a whole, it is the appellants position that Dokoupil only vents during the process of securing the lid, not when the lid

is secure and that it does not logically follow that venting necessarily occurs if the lid is loosely placed on the container merely because venting occurs during the process of placing the lid on the container. Accordingly, the appellants submit that the rejection of claim 1 lacks foundation in fact and logic and should be reversed.

We find ourselves in agreement with the appellants that Dokoupil only vents during the process of securing the lid 24 to the container 12 and not necessarily when the lid 24 is secured or loosely placed on the container 12. However, claim 1 is directed to the lid, per se, and not to the combination of the lid with a bowl (i.e., container). It is well settled that the manner or method in which a device is to be used is not germane to the issue of the patentability of the device itself. See In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations (i.e., is capable of performing the claimed limitations), it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Thus, to anticipate claim 1 it is necessary that Dokoupil's lid be inherently capable of performing the recited intended use in order to satisfy the functional limitation in question. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

Thus, claim 1 would be anticipated by Dokoupil's lid 24 if Dokoupil's lid is capable of being loosely placed on a suitable bowl such that Dokoupil's vents 42 define air passageways between the rim of the bowl and the lid when the lid rests loosely on the bowl. In our view, Dokoupil's lid is clearly capable of being loosely placed on a suitable bowl such that Dokoupil's vents 42 define air passageways between the rim of the bowl and the lid when the lid rests loosely on the bowl.¹ Accordingly, claim 1 is anticipated under the principles of inherency by Dokoupil's lid.

After the USPTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, the appellants' burden before the USPTO is to prove that Dokoupil's lid is not capable of performing the function defined in claim 1 under appeal. The appellants have not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

¹ For example, if Dokoupil's container were sized such that the step in sides 16, which supports step 36 of lid 24 (see Figures 3, 4 and 6), barely supported bead 40 of lid 24, prior to the lid being closed on the container, so as to define an air passageway from the interior of the container to the ambient via vents 42.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed. In view of the appellants grouping of claims 1, 3 to 7, 9 to 17 and 19 to 24, the decision of the examiner to reject claims 3 to 5, 9 to 12, 15 to 17 and 19 to 22 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 6, 7, 13, 14, 23 and 24 under 35 U.S.C. § 103 is affirmed.

The appellants argue that claims 8, 18 and 25 are not anticipated by Dokoupil since there is no disclosure that Dokoupil's tab 34 is rigid.² In that regard, the appellants note that while Dokoupil's tab *could* be rigid since Dokoupil discloses a thermoplastic container package 10 having a lid 24 with a tab 34 such mere possibilities are insufficient to establish inherency. We agree.³ Accordingly, the decision of the examiner to reject claims 8, 18 and 25 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 to 5, 9 to 12, 15 to 17 and 19 to 22 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to

² The American Heritage Dictionary of the English Language, Third Edition, (1992) defines "rigid" as "[n]ot flexible or pliant; stiff."

³ The examiner did not respond to this argument in the answer or explain in the rejection how Dokoupil's lid meets this limitation of claims 8, 18 and 25.

reject claims 8, 18 and 25 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 6, 7, 13, 14, 23 and 24 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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APPEAL NO. 2004-1271 - JUDGE NASE
APPLICATION NO. 09/370,913

APJ NASE

APJ ABRAMS

APJ BAHR

DECISION: **AFFIRMED-IN-PART**

PREPARED: Jan 1, 2005

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

GAU:

HEARD: August 18, 2004